

REMARKS

Claims 32, 34 and 35 is canceled without prejudice, and therefore claims 14, 15, 19 to 21, 27 to 31, and 33 are now pending and being considered in the present application (*since claims 22 to 26 were previously withdrawn in response to a restriction requirement*).

In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for indicating that claims 31 to 35 contain allowable subject matter. While the objections may not be agreed with, to facilitate matters, claim 14 has been rewritten to include the features of claim 32, which has been canceled without prejudice. Claim 33 now depends from claim 14. Also, like claim 14, claim 30 has been rewritten to include the features of now canceled claim 32.

Claims 34 and 35 have been canceled without prejudice, since their features are reflected in claims 14 and 33, as presented.

Accordingly, all of claims 14, 15, 19 to 21, 27 to 31, and 33 are allowable, and it is therefore respectfully requested that the objections be withdrawn.

Claims 14, 15, 19 to 21, and 27 to 30 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,253,123 to Schramm et al., (“Schramm”).

To reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law

make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

While the rejections may not be agreed with, to facilitate matters, claim 14 has been rewritten to include the features of claim 32, which has been canceled without prejudice. Claim 33 now depends from claim 14. Also, like claim 14, claim 30 has been rewritten to include the features of now canceled claim 32. Claims 34 and 35 have been canceled without prejudice, since their features are reflected in claims 14 and 33, as presented.

Accordingly, all of claims 14, 15, 19 to 21, 27 to 31, and 33 are allowable, and it is therefore respectfully requested that the anticipation rejections be withdrawn.

CONCLUSION

In view of the foregoing, it is respectfully submitted that pending and considered claims 14, 15, 19 to 21, 27 to 31, and 33 are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,
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